UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,533	01/04/2005	Aki Niemi	059643.00550	8981

32294 7590 08/05/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.
8000 TOWERS CRESCENT DRIVE
14TH FLOOR
VIENNA, VA 22182-6212

EXAMINER	
ALAM, FAYYAZ	

ART UNIT	PAPER NUMBER
2618	

MAIL DATE	DELIVERY MODE
08/05/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/517,533	NIEMI ET AL.	
	Examiner	Art Unit	
	FAYYAZ ALAM	2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 May 2008*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's argument filed 5/27/2008 are persuasive, rejection withdrawn. However, rejection still stands under new grounds.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 38-39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims disclose "computer readable medium" without specifying what the medium is, either in the specification or the claims.

Claims 38-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase "computer readable medium" is not properly described in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 - 7, 11 - 30, and 34 - 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bobde et al. (U.S. Application # 2003/0217142)** and further in view of **Wang (USPN 2002/0131395).**

Consider **claims 1, 34, 38, and 39**, Bobde et al. disclose a method in a communication system (see title), the system comprising:

a registrar or registration program (154) (read as first network element and registrar server) for maintaining registration information (see [0028]; [0029]; figure 3; a registration program along with a registrar is disclosed in paragraph [0029] to process registration information, therefore it inherently maintains registration) from user (103) and user (107) (read as plurality of users; see figure 3)

a presence agent (152) (read as second network element and presence server) for maintaining presence information (read as information) associated with said user (103) and user (107) (read as plurality of users), wherein said presence agent (read as second network element) information is dependent on the registration information ([0028]; [0029]; figure 3), and said method comprising:

sending notifications (read as sending a subscribe message; [0028]) of changes in the presence of computing devices (read as an event) from the presence agent (152) (read as second element) to the registrar or registration program (154) (read as first entity and registrar server; examiner takes note that it is not explicitly disclosed in paragraph [0028] but it is stated that one of the tasks of the presence agent (152) is to "generate notifications of changes" which would inherently be sent or queried to the "registrar" since that is where the user registration resides), wherein the change in the

presence of computing devices (read as event) is an introduction of a user to the network (read as change in registration information; [0028]) of at least first user (103) (read as one of the plurality of users at the first element; [0028]);

receiving at the registrar or registration program (154) (read as first element and registrar server) a register message ([0028]) from at least user (103) (read as one user), said message changing the registration information (by way of processing presence information) of said at least user (103) (read as one user) ([0028]);

The invention as disclosed by Bobde et al. does not explicitly disclose sending a notification from the first element and registrar server to the second element and presence server in response to the register message, wherein the notification includes information associated with said at least one user.

In the related field of endeavor, **Wang (U.S. Application # 2002/0131395),** clearly discloses an application server (read as first element and registrar server) forwarding information (read as notification) to the presence server in response to SIP REGISTER (1204) message (see [0080]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to acquire presence information from the presence server in the event that a given user is offline and thus the presence status would need to be retrieved from the presence server.

However, Bobde as modified by Wang dose not explicitly disclose second network element separate from the first network element.

Nevertheless, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Bobde and Wang in order to reduce loading in one server and provide more efficient processing.

Consider **claims 2, 19, and 25** in view of claims 1, 17, and 18, Bobde et al. as modified by Wang disclose a method, where an event header (read as event package [0030]; since the header inherently defines the type of package) is defined, the event header (read event package) being associated with said change in presence of computing device (read as an event) ([0030]).

Consider **claims 3, 20, and 26** in view of claims 2, 17, and 18, Bobde et al. as modified by Wang disclose a method, wherein a registrar or a registration program (154) (read as first entity; [0029]) is defined.

Consider **claims 4, 21, and 27** in view of claims 3, 17, and 18, Bobde et al. as modified by Wang disclose a method, wherein the change in registration information relates to presence information ([0028]).

Consider **claims 5, 22, and 28** in view of claims 4, 17, and 18, Bobde et al. as modified by Wang disclose a method, wherein a presence agent (152) (read as second entity) is a presence server ([0028]).

Consider **claims 6, 23, and 29** in view of claims 1, 17, and 18, Bobde et al. as modified by Wang disclose a method, wherein the system (read as invention) operates in accordance with a session initiation protocol or SIP ([0022]).

Consider **claims 7, 24, and 30** in view of claims 6, 17, and 18, Bobde et al. fail to disclose the method, wherein the subscribe message comprises a SIP SUBSCRIBE message, and the notification comprises a SIP NOTIFY message.

In the related field of endeavor, Wang discloses SIP SUBSCRIBE/NOTIFY message for subscription and notification of presence status ([0078]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to use the conventional and well-known communication messages in session initiation protocol to comply with industry standard and furthermore conserve financial resources.

Consider **claim 11**, Bobde et al. disclose a communication system (see title) comprising:

a registrar (154) (read as first network element and registrar server) for maintaining registration information ([0028]; [0029]; figure 3; a registration program along with a registrar is disclosed in paragraph [0029] to process registration information, therefore it inherently maintains registration) from user (103) and user (107) (read as plurality of users; see figure 3);

a presence agent (152) (read as second network element and presence server) for maintaining presence information (read as information) associated with said user (103) and user (107) (read as plurality of users), wherein said presence agent (read as second network element and presence server) information is dependent on the registration information ([0028]; [0029]; figure 3);

said presence agent (152) (read as second network element and presence server) operable to send notifications (read as sending a subscribe message; [0028]) of changes in the presence of computing devices (read as an event) to the registrar (154) (read as first network element and registrar server), and said registrar or registration program (154) (read as first network element and registrar server) operable to receive a register message ([0028]) from at least user (103) (read as one user), said register message changing the registration information (by way of processing presence information) of said at least user (103) (read as one user), wherein the change in the presence of computing devices (read as event) is associated with the introduction of a user to the network (read as change in registration information; [0028]) of at least user (103) or user (107) (read as one of the plurality of users at the first entity and registrar server; [0028]) at the registrar (read as first entity and registrar server; see [0028]).

The invention as disclosed by Bobde et al. fail to disclose said first network element and registrar server operable to send a notification from the first network element to the second network element in response to the register message, wherein the notification includes information associated with said at least one user.

In the related field of endeavor, **Wang (U.S. Application # 2002/0131395),** clearly discloses an application server (read as first network element and registrar server) forwarding information (read as notification) to the presence server in response to SIP REGISTER (1204) message (see [0080}.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in

order to acquire presence information from the presence server in the event that a given user is offline and thus the presence status would need to be retrieved from the presence server.

However, Bobde as modified by Wang dose not explicitly disclose second network element separate from the first network element.

Nevertheless, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Bobde and Wang in order to reduce loading in one server and provide more efficient processing.

Consider **claim 12** in view of claim 11, Bobde et al. as modified by Wang disclose a communication system further comprising an event header (read as event package [0030]; since the header inherently defines the type of package) associated with said change in presence of computing device (read as an event) ([0030]).

Consider **claim 13** in view of claim 12, Bobde et al. as modified by Wang disclose a communication system with a registrar or a registration program (154) (read as first entity; [0029]; figure 3).

Consider **claim 14** in view of claim 13, Bobde et al. as modified by Wang disclose a communication system, wherein the change in registration information relates to presence information ([0028]).

Consider **claim 15** in view of claim 4, Bobde et al. as modified by Wang disclose a communication system, wherein a presence agent (152) (read as second entity) is a presence server ([0028]).

Consider **claim 16** in view of claim 1, Bobde et al. as modified by Wang disclose a communication system, wherein the system (read as invention) operates in accordance with a session initiation protocol or SIP ([0022]).

Consider **claims 17, 36, and 40**, Bobde et al. disclose a network element and a registrar server (see figure 3) comprising:

storage circuitry configured to maintain registration information (see [0028]; [0029]; figure 3; a registration program along with a registrar is disclosed in paragraph [0029] to process registration information, therefore it inherently would have storage circuitry to maintain registration information) from user (103) and user (107) (read as plurality of users; see figure 3);

receiving circuitry configure to receive notifications (read as receiving a subscribe message; [0028]; figure 3) of changes in the presence of computing devices (read as an event) from a registrar (154) (read as first entity), wherein the change in the presence of computing devices (read as event) is associated with an introduction of a user to the network (read as change in registration information; [0028]) of at least first user (103) (read as one of the plurality of users at the first entity; [0028]) at the network element (figure 3);

receiving circuitry configured to receive a register message ([0028]) from at least first user (read as one user), said register message changing the registration information (by way of processing presence information) of said at least first user (read as one user) ([0028]);

The invention as disclosed by Bobde et al. fail to disclose transmitting circuitry configured to send a notification to the first entity and presence server in response to the register message, wherein the notification includes information associated with said at least one user.

In the related field of endeavor, **Wang (U.S. Application # 2002/0131395),** clearly discloses inherently a transmitting circuitry in the application server (read as first entity and registrar server) forwarding information (read as notification) to the presence server in response to SIP REGISTER (1204) message (see [0080).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to acquire presence information from the presence server in the event that a given user is offline and thus the presence status would need to be retrieved from the presence server.

However, Bobde as modified by Wang dose not explicitly disclose second network element separate from the first network element.

Nevertheless, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Bobde and Wang in order to reduce loading in one server and provide more efficient processing.

Consider **claims 18, 37, and 41**, Bobde et al. disclose a network element and presence server (see figure 3) comprising:

storage circuitry configured to maintain presence information (read as information) associated with said first user (103) and second user (read as plurality of

users), wherein said information is dependent on the registration information ([0028]; [0029]; figure 3), maintained at registrar (154) (read as first entity and registrar server);

transmitting circuitry configured to send notifications (read as sending a subscribe message; [0028]) of changes in the presence of computing devices (read as an event) to the registrar (154) (read as first entity and registrar server), wherein the change in the presence of computing devices (read as event) is associated with an introduction of a user to the network (read as change in registration information; [0028]) of at least first user (103) (read as one of the plurality of users at the first entity; [0028]);

The invention as disclosed by Bobde et al. fail to disclose receiving circuitry configured to receive a notification from the first entity and registrar server, wherein the notification includes information associated with said at least one user.

In the related field of endeavor, **Wang (U.S. Application # 2002/0131395),** clearly discloses receiving circuitry, inherently, and an application server (read as first entity and registrar server) forwarding information (read as receiving notification) to the presence server in response to SIP REGISTER (1204) message (see [0080]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to acquire presence information from the presence server in the event that a given user is offline and thus the presence status would need to be retrieved from the presence server.

However, Bobde as modified by Wang dose not explicitly disclose second network element separate from the first network element.

Nevertheless, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Bobde and Wang in order to reduce loading in one server and provide more efficient processing.

Claims 8 - 9 and 31 - 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bobde et al. (U.S. Application # 2003/0217142)** in view of **Wang (U.S. Application # 2002/0131395)** as applied to claims above, and further in view of **Donovan ("IMPS - Instant Messaging and Presence Using SIP. Fall VON Developers' Conference", Sep. 13, 2000, www.dynamicsoft.com).**

Consider **claims 8 and 31** in view of claims 1 and 18, Bobde et al. as modified by Wang fail to disclose a method, wherein a third entity sends a subscribe message to the second entity for information associated with said at least one user.

In the related field of endeavor, Donovan discloses a method, wherein a proxy server (read as third entity) sends a subscribe message to presence server (read as second entity for information associated with at least one user (see figure on page 7).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Donovan with that of Bobde et al. and Wang since this signaling scheme is well known and exists in most applications in the application layer and would provide convenience and conservation of financial resources.

Consider **claims 9 and 32** in view of claims 8 and 18, Bobde et al. as modified by Wang fail to disclose the method, wherein the second entity s ends a notification to

the third entity in response to the notification received at the second entity, wherein said sent notification includes information associated with said at least one user.

In the related field of endeavor, Donovan discloses the method, wherein the presence server (read as second entity) sends an accepted message (read as notification) to the proxy server (read as third entity) in response to the subscribe (read as notification) received at the presence server (read as second entity), wherein said sent accepted message (read as notification) includes information associated with said at least one user (Donovan, page 7).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Donovan with that of Bobde et al. and Wang since this signaling scheme is well known and exists in most applications in the application layer.

Claims 10 and 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bobde et al. (U.S. Application # 2003/0217142)** and further in view of **Wang (U.S. Application # 2002/0131395).**

Consider **claims 10 and 33** in view of claims 8 and 18, Bobde et al. fail to disclose the method, wherein the third entity is an application server.

In the related field of endeavor, Wang clearly disclose an application server (216) ([0031 - 0040]).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention to incorporate the teachings of Wang with that of Bobde et al. in order to provide various multimedia capabilities other than just presence status.

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Fayyaz Alam whose telephone number is (571) 270-1102. The Examiner can normally be reached on Monday-Friday from 9:30am to 7:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Edward Urban can be reached on (571) 272-7899. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Fayyaz Alam

July 21, 2008

/Edward Urban/

Supervisory Patent Examiner, Art Unit 2618